

7/24/02
Hearing:
June 13, 2002

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Paper No. 41
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

En Fleur Corporation
v.
Microsoft Corporation

Cancellation No. 26,548

William L. Flowers, Jr., Chief Executive Officer of En
Fleur Corporation for En Fleur Corporation.

William O. Ferron, Jr. of Seed and Berry, LLP for
Microsoft Corporation.

Before Cissel, Walters and Bucher, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On June 21, 1994, Registration No. 1,872,264 issued
on the Principal Register, under the provisions of
Section 2(f) of the Lanham Act to Microsoft Corporation,
a corporation organized and existing under the laws of
the state of Delaware. This registration is for the mark
"WINDOWS" for "computer programs and manuals sold as a
unit; namely, graphical operating environment programs
for microcomputers." On January 12, 2000, registrant

filed an affidavit under Section 8 of the Act, and this affidavit was accepted on December 8, 2000.

On July 10, 1997, however, a Petition to Cancel had been filed by En Fleur Corporation, a North Carolina corporation located in Louisburg, North Carolina. As grounds for cancellation, petitioner asserted priority and likelihood of confusion with petitioner's unregistered mark "WINDOWPAD" for an integrated windowing and note processing utility software program. Petitioner also pleaded that the mark in the registration it seeks to cancel is merely descriptive of the goods specified in the registration and had not acquired distinctiveness. Respondent's answer denied that petitioner had priority, denied that confusion is likely, and denied that the registered mark is merely descriptive of the goods specified in the registration. Respondent also pleaded in its answer that petitioner had abandoned any rights it may have had in the mark it asserted against respondent's registered mark.

Petitioner's Chief Executive Officer, Mr. Flowers, who is not an attorney, has represented petitioner throughout this proceeding. This created some procedural problems which the Board has attempted to correct during the trial, which was conducted in accordance with the

Trademark Rules of Practice. Eventually, discovery and the trial were completed, briefs were filed by both parties, and an oral hearing was conducted before the Board.

The issues which were pleaded and tried are whether petitioner's mark is merely descriptive, and if so, whether it acquired distinctiveness prior to respondent's first use of its mark; whether petitioner, even if it had priority, subsequently abandoned its mark; and if not, whether respondent's mark so resembles respondent's mark and petitioner's goods are so closely related to respondent's goods that confusion is likely.

Petitioner, as plaintiff in this proceeding, has the burden of proof with regard to priority and likelihood of confusion. Respondent has the burden with respect to proving that petitioner abandoned use of its mark. In order to establish a prima facie case of abandonment, respondent needed to show that petitioner had not used its mark for a period of at least three years with no intent to continue use of the mark. If respondent managed to do this, then the burden shifted to petitioner to show why this period of nonuse should not be considered proof that petitioner has abandoned its mark.

West Florida Seafood v. Jet Restaurants, 31 F.3d 1122, 31 USPQ2d 1660, (Fed. Cir. 1994).

Despite the Board's earlier warning that Mr. Flowers needed to familiarize himself with proper Board practice and procedure, the record demonstrates that Mr. Flowers did not fully comprehend the requirements set forth in the Trademark Rules of Practice. For whatever reason, petitioner made of record no testimony of its own witnesses and very little evidence.

As the Board's ruling on respondent's motion to dismiss noted, the only documents properly made of record by petitioner are its 1984 copyright registration and three advertisements for petitioner's software from 1984 and 1985. Petitioner's record also includes portions of the testimony deposition of Rao Remala, an employee of respondent who was involved in the development and introduction of the "WINDOWS" operating environment software, taken by respondent, and respondent's response to Interrogatory No. 6.

As the Board ruled on April 3, 2001, the other submissions of petitioner are not properly of record. Further, respondent's motion to strike the five articles petitioner submitted during its rebuttal period is granted. As respondent points out, these articles were

submitted for the proposition that respondent first sold goods under its registered mark after petitioner first used its mark. The articles constitute inadmissible hearsay as to this proposition. Moreover, as the testimony properly made of record by respondent clearly establishes, respondent established rights in its mark well prior to the actual first sales transactions involving goods bearing the mark by establishing use analogous to trademark use of the mark in advertising and promotional activities as early as September of 1983. This use was followed soon by actual sales of product bearing the mark. Accordingly, whether respondent's technical trademark use took place in 1984 or 1985 does not really matter. That is, even if the five articles were considered to establish respondent's first technical trademark use, our conclusion with respect to priority would not change. The record shows that petitioner did not even exist until May of 1984, the year after respondent first used its mark.

Respondent made of record the testimonial depositions, with exhibits, of Jerry J. Dunietz, Rao Ramala, Scott Behm, and Michael Harlan Van Alstyne, along with portions of the December 19, 1997 and June 8, 1998 discovery deposition testimony of Mr. Flowers, and

documents properly submitted by means of respondent's Notice of Reliance.

What the evidence shows is that respondent began use of its registered mark to promote its new product to original equipment manufacturers of computers and to the press in the Fall of 1983, including at the national introduction of Microsoft's "WINDOWS" operating environment software in New York and at the COMDEX trade show in Las Vegas. Substantial publicity was given to both events, and respondent spent a good deal of money promoting its goods under the "WINDOWS" mark from that point forward, up to and including the testimony periods in this proceeding.

By the close of 2001, respondent had spent an astounding \$1.2 billion for advertising and promoting the "WINDOWS" product, which has resulted in more than \$37 billion in sales. According to Mr. Van Alstyne, respondent's senior financial analyst, at the time he gave his testimony in July of 2001, there were over 384 million users of respondent's product bearing the "WINDOWS" trademark. Not surprisingly, in view of these and other facts, the Board, in its ruling of April 25, 2000, acknowledged that the "WINDOWS" mark, although originally merely descriptive of respondent's product,

was properly registered with respondent's claim of acquired distinctiveness. The Board therefore dismissed the petition to cancel as it relates to petitioner's pleading that respondent's registration should be cancelled because the mark is descriptive of the goods on which it is used and has not acquired distinctiveness.

On the other hand, petitioner's Chief Executive Officer testified that petitioner's mark is descriptive of petitioner's programs. According to Mr. Flowers, he picked the mark "WINDOWPAD" for his company's product because "...the name I chose ... would describe the product and give the individual an idea what it would do. WindowPad. You have a window and it's like a notepad." (Flowers' December 19, 1997 deposition, at 22:13-30).

Although the record conclusively shows that acquired distinctiveness resulted from respondent's widespread promotion and tremendous sales of its "WINDOWS" software, nothing in this record establishes that petitioner's mark ever acquired distinctiveness as a trademark.

In view of the fact that the record is also devoid of evidence establishing any sales or promotion of petitioner's "WINDOWPAD" software since 1987 (at the latest), that petitioner did not establish that its mark acquired secondary meaning is not critical. By showing

that petitioner has not used its mark on any products sold since then, respondent has established a prima facie case of abandonment, and petitioner has failed to rebut it with anything other than self-serving testimony that it intends to resume use in the future and the unsubstantiated conjecture that old copies of its software, which was only usable with an obsolete Tandy computer, might be in use as training tools somewhere. Petitioner has not demonstrated ongoing use of its mark, nor has it established any factual basis upon which the Board could conclude that petitioner has a viable intent to resume use of its mark, or that its non-use is excusable.

Not only has petitioner failed to prove that it used its mark before respondent's use of its mark, but petitioner has also not rebutted respondent's prima facie showing that petitioner abandoned its mark through non-use. Because petitioner cannot claim rights in a mark it abandoned more than a decade ago, we do not even get to the question of whether the marks, as applied to the goods of the parties, so resemble each other that confusion is likely.

DECISION: The petition to cancel is dismissed with prejudice.